

REMARKS

Claims 18-27, 50-59, 69, 70, 76, and 77 are pending in the application. Applicants have amended independent claims 18, 23, 50, 55, 69, 70, 76, and 77. Applicants respectfully request reconsideration of the claims in view of the foregoing amendments and the following remarks.

Section 101 Rejections:

The Office Action rejects claims 1-12 under 35 U.S.C. § 101. Office Action at pages 2 and 3. Because claims 1-12 have been canceled in response to a restriction requirement, the rejection is rendered moot and Applicants respectfully request that the rejections under 35 U.S.C. § 101 be withdrawn.

Applicants reserve the right to pursue claims 1-12 and all other non-elected claims in one or more divisional applications.

Section 102 Rejections:

The Office Action rejects claims 18-20, 22-25, 27, 50-52, 54-57, 59, 69-70, and 76-77 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,805,810 to

Maxwell (Maxwell). Office Action at pages 3 and 4. Applicants traverse the rejection for at least the reason that Maxwell fails to disclose all features recited in the claims.

Independent claims 18, 50, 69, and 76 each recite a message including an “electronic address associated with the user’s electronic account.” As recited in the preamble of independent claims 18, 50, 69, and 76, the claimed “user” is a recipient of the message. By contrast, Maxwell discloses that an electronic address, such as “mom@netgram.com,” is associated with the *sender’s* electronic account. See e.g., column 6, line 25 of Maxwell (characterizing the Netgram architecture 10 as the “*sender’s* email host”); see also Figure 6 (reference in steps 610 and 620 to the *sender’s* account). Applicants respectfully submit that Maxwell does not anticipate independent claims 18, 50, 69, and 76, and they are allowable for at least this reason.

In addition, independent claims 18, 50, 69, and 76 each recite a received message having “a partial physical address of the user.” By contrast, Maxwell does not disclose a received message having “a partial physical address of the user.” Instead, Maxwell discloses that physical address information 1440 is supplied by a database 1400 of the “Netgram” system based on the combination of Sender ID 1410 and Recipient Nickname ID 1430. See Figure 14 of Maxwell. Applicants respectfully submit that Maxwell does not anticipate independent claims 18, 50, 69, and 76, and they are allowable for at least this additional reason.

Claims 19, 20, and 22 are patentable for at least the reason that they depend from allowable claim 18. Claims 51, 52, and 54 are patentable for at least the reason that they depend from allowable claim 50.

With further regard to dependent claims 19 and 51, Applicants note that these claims recite a method and system, respectively, including delivery of the message “to the user at the electronic address.” As recited in the preamble of independent claims 18 and 50, from which claims 19 and 51 depend, respectively, the claimed “user” is a recipient of the message. By contrast, Maxwell discloses that a recipient’s electronic address, such as “mom@netgram.com,” is used to deliver a message to a *sender’s* email host, not to the recipient. See e.g., column 6, line 25 of Maxwell (characterizing the Netgram architecture 10 as the “sender’s email host”). Maxwell teaches that the recipient receives the message as printed mail at a physical address. See Figure 2 of Maxwell. Applicants respectfully submit that dependent claims 19 and 51 are allowable for at least this additional reason.

Independent claims 23, 55, 70, and 77 each variously recite a message including “an incomplete electronic address of the user.” Maxwell does not disclose “an incomplete electronic address of the user.” Instead, Maxwell discloses use of a complete recipient’s electronic address, such as “mom@netgram.com.” Applicants respectfully submit that Maxwell therefore does not anticipate independent claims 23, 55, 70, and 77, and they are allowable for at least this reason.

In addition, independent claims 23, 55, 70, and 77 each recite a received message having “a physical address of the user.” But Maxwell does not disclose a received message having “a physical address of the user.” Instead, Maxwell discloses that physical address information 1440 is supplied by a database 1400 of the “Netgram” system based on the combination of Sender ID 1410 and Recipient Nickname ID 1430. See Figure 14 of Maxwell and associated description beginning at column 9, line 48 of Maxwell. Applicants respectfully submit that Maxwell does not anticipate independent claims 23, 55, 70, and 77, and they are allowable for at least this additional reason.

Claims 24, 25, and 27 are patentable for at least the reason that they depend from allowable claim 23. Claims 56, 57, and 59 are patentable for at least the reason that they depend from allowable claim 55.

With further regard to dependent claims 24 and 56, Applicants note that these claims recite a method and system, respectively, including delivery of the message “to the user at the electronic address.” As recited in the preamble of independent claims 23 and 55, from which claims 24 and 56 depend, respectively, the claimed “user” is a recipient of the message. By contrast, Maxwell discloses that a recipient’s electronic address, such as “mom@netgram.com,” is used to deliver a message to a *sender’s* email host, not to the recipient. See *e.g.*, column 6, line 25 of Maxwell (characterizing the Netgram architecture 10 as the “sender’s email host”). Maxwell teaches that the

recipient receives the message as printed mail at a physical address. See Figure 2 of Maxwell. Applicants respectfully submit that dependent claims 24 and 56 are allowable for at least this additional reason.

Applicants respectfully request that the rejections under 35 U.S.C. § 102 be withdrawn.

Section 103 Rejections:

The Office Action rejects claims 21, 26, 53, and 58 under 35 U.S.C. § 103(a) as being obvious over Maxwell in view of U.S. Patent No. 5,341,505 to Whitehouse (Whitehouse). Office Action at pages 4 and 5. Applicants traverse the rejection for at least the reason that Maxwell and Whitehouse, either separately or combined, fail to disclose all features recited in the claims.

With respect to claims 21 and 53, the Office action asserts that Maxwell discloses all recited features except "sending back information of a complete physical address." Office Action at page 4. The Office Action then asserts that Whitehouse discloses this feature. Id.

As a threshold matter, Applicants respectfully submit that Whitehouse does not overcome the deficiencies of Maxwell explained above, namely that Maxwell does not

disclose at least a received message having an “electronic address associated with the user’s electronic account” or “a partial physical address of the user” as recited in claims 18 and 50, from which claims 21 and 53 depend, respectively. Applicants respectfully submit that claims 21 and 53 are not obvious for at least this reason.

With further regard to claims 21 and 53, Applicants respectfully submit that Whitehouse does not disclose “informing a sender of the complete physical address,” as variously recited in claims 21 and 53. Instead, Whitehouse discloses only that “zip + 4” information is returned to the sender. See Title, Abstract, and column 5, line 57 through column 6, line 5 of Whitehouse. Applicants respectfully submit that “zip + 4” information, by itself, cannot be a “complete physical address.” Claims 21 and 53 are not obvious for at least this additional reason.

With respect to claims 26 and 58, Applicants respectfully submit that Whitehouse does not overcome all of the deficiencies of Maxwell explained above, since even Maxwell does not disclose a received message having at least an “incomplete electronic address of the user,” as recited in claims 23 and 55, from which claims 26 and 58 depend, respectively. Applicants respectfully submit that claims 26 and 58 are not obvious for at least this reason.

With further regard to claims 26 and 58, each variously recite “informing a sender of the complete electronic address.” Neither Maxwell nor Whitehouse disclose this

feature. Instead, Maxwell teaches that the recipient receives the message as printed mail at a physical address. See Figure 2 of Maxwell. And Whitehouse discloses only that "zip + 4" information is returned to the sender. See Title, Abstract, and column 5, line 57 through column 6, line 5 of Whitehouse. Moreover, claims 26 and 58 recite different subject matter than claims 21 and 53, and so do not "map directly" to claim 21 as the Office Action asserts. Office Action at page 5. Consequently, the Office Action does not address the features recited in these claims. Claims 26 and 58 are not obvious for at least these additional reasons.

Applicants respectfully request that the rejections under 35 U.S.C. § 103 be withdrawn.

Conclusion:

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims. If the Examiner believes that an interview would advance prosecution, the Examiner is invited to contact the undersigned at (571) 203-2700.

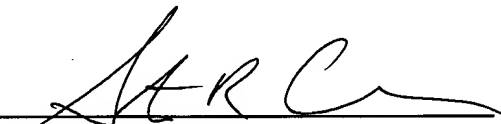
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 18, 2005

By: _____

A handwritten signature in black ink, appearing to read "S. R. Olsen", written over a horizontal line.

Steven R. Olsen
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